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DAF11w
Docket No.: 600.1294
Date: May 8, 2006

In re application of: **Lars Christian HERZBACH et al.**
Serial No.: 10/730,464
Filed: December 8, 2003
For: **DEVICE FOR PROCESSING FOR A PRINTING SUBSTRATE**

Sir:

Transmitted herewith is an **Appellants' Brief Under 37 C.F.R. §41.37 (11 pgs)** in the above-identified application.

- ☒ Also transmitted herewith are:
- ☐ Petition for extension under 37 C.F.R. 1.136
 - ☒ Other: **Return Receipt Postcard**
- ☒ Check(s) in the amount of **\$500.00** is/are attached to cover:
- ☐ Filing fee for additional claims under 37 C.F.R. 1.16
 - ☐ Petition fee for extension under 37 C.F.R. 1.136
 - ☒ Other: **Fee for Filing a Brief in Support of an Appeal under 37 C.F. R. §41.20(b)(2)**
 - ☐ Other:
- ☒ The Assistant Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 50-0552.
- ☒ Any filing fee under 37 C.F.R. 1.16 for the presentation of additional claims which are not paid by check submitted herewith.
 - ☒ Any patent application processing fees under 37 C.F.R. 1.17.
 - ☒ Any petition fees for extension under 37 C.F.R. 1.136 which are not paid by check submitted herewith, and it is hereby requested that this be a petition for an automatic extension of time under 37 CFR 1.136.

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I hereby certify that the documents referred to as attached therein and/or fee are being deposited with the United States Postal Service as "first class mail" with sufficient postage in an envelope addressed to "Mail Stop: APPEAL BRIEF - PATENTS Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on May 8, 2006.

DAVIDSON, DAVIDSON & KAPPEL, LLC

BY:

Jennifer L. O'Connell



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Re: Application of: **Lars Christian HERZBACH, et al.**

Serial No.: 10/730,464

Filed: December 8, 2003

For: **DEVICE FOR PROCESSING FOR A PRINTING
SUBSTRATE**

Docket No.: 600.1294

Art Unit: 2929

Examiner: Kevin D. WILLIAMS

Art Unit: 2854

Customer No.: 23280

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

May 8, 2006

APPELLANTS' BRIEF UNDER 37 C.F.R. § 41.37

Sir:

Appellants submit this brief for the consideration of the Board of Patent Appeals and Interferences (the "Board") in support of their appeal of the Final Rejection dated December 5, 2005 in this application. The statutory fee of \$500.00 is paid concurrently herewith.

1. REAL PARTY IN INTEREST

The real party in interest is Heidelberger Druckmaschinen AG, a German corporation having a place of business in Heidelberg, Germany, and the assignee of the entire right, title and interest in the above-identified patent application. The invention was assigned to Heidelberger Druckmaschinen AG by inventors Lars Christian Herzbach, Joerg Oliver Kain, and Monika Bluemm. The assignment was recorded at reel 014777, frame 0697 on December 8, 2003.

2. RELATED APPEALS AND INTERFERENCES

Appellants, their legal representatives, and assignee are not aware of any appeal, interference or judicial proceeding that directly affects, will be directly affected by, or will have a bearing on the Board's decision in this appeal.

3. STATUS OF CLAIMS

Claims 1 to 17 are pending. Claims 1 to 17 have been finally rejected as per Final Office Action dated December 5, 2005.

The rejection to claims 1 to 17 thus is appealed. A copy of appealed claims 1 to 17 is attached hereto as Appendix A.

4. STATUS OF AMENDMENTS AFTER FINAL

No amendments to claims were filed after the final rejection. An advisory action was issued on April 6, 2006. A Notice of Appeal was filed on March 2, 2006 and received by the U.S.P.T.O. on March 6, 2006.

5. SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent claim 1 recites a device for processing a printing substrate (see, e.g. paragraph [0022] of the specification, Fig. 1) comprising a rotatable carrier body (see, e.g. paragraph [0022] of the specification, 14 in Fig. 1); and at least one processing tool (see, e.g. paragraph [0022] of the specification, 10 in Fig. 1) accommodated on the rotatable carrier body, the carrier body having, at least partially, a magnetizable coating (see, e.g. paragraph [0022] of the specification, 16 in Fig. 1), the magnetizable coating when magnetized holding the

processing tool on the carrier body by magnetic force (see, e.g. paragraph [0022] of the specification).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1, 8 to 10, 12 and 16 should be rejected under 35 U.S.C. §102(b) as being anticipated by Wright (US 3,810,055). Whether claims 2, 6, 7, 13 to 15 and 17 should be rejected under 35 U.S.C. §103(a) as being unpatentable over Wright in view of Koga (US 5,424,815). Whether claims 3 and 4 should be rejected under 35 U.S.C. §103(a) as being unpatentable over Wright in view of Bain (US 5,038,680). Whether claim 5 should be rejected under 35 U.S.C. §103(a) as being unpatentable over Wright in view of Friedrichs (DE 101 47 486 A1). Whether claim 11 should be rejected under 35 U.S.C. §103(a) as being unpatentable over Wright in view of Albus (US 2001/0045166).

7. ARGUMENTS

Rejections under 35 U.S.C. §102(b)

Claims 1, 8 to 10, 12 and 16 were rejected under 35 U.S.C. §102(b) as being anticipated by Wright (US 3,810,055).

Wright discloses a magnetic holding device in which a strip 14 of permanent magnetic material is placed in gaps or slots 13. The slots are machined into the cylinder. See col. 2, lines 50 to 62. Wright goes on to say that once this strip is in place:

It is also contemplated that protection against wear can be achieved by coating the entire cylinder with a thin layer of some suitable protective material without substantially affecting the magnetic holding strength. Col 2, lines 10 to 15.

Claim 1 recites a “device for processing a printing substrate comprising:

a rotatable carrier body; and

at least one processing tool accommodated on the rotatable carrier body, the carrier body having, at least partially, a magnetizable coating, the magnetizable coating when magnetized holding the processing tool on the carrier body by magnetic force.”

The final office action asserts that the strips 14 of magnetic material are “a magnetizable coating.” However, under any definition, these strips are not a coating. The Examiner himself has proffered a definition of coating as “a layer of a substance spread over a surface **for protection or decoration.**” The magnetic strip of Wright is not for protection as it already is in a milled groove, and is clearly is not for decoration. Thus the Office Action is on its face in error. While Applicant does not agree with the proffered definition, it is respectfully submitted that even under the definition given by the Examiner, the flexible strip of magnetic material in Wright is not a coating.

The Advisory Action states that the strip of Wright is “capable of protecting the cylinder from outside materials.” However, the strip in Wright clearly is not “for protection” as in the Examiner’s own definition of coating, as Wright even states that additional nonmagnetic protection be added over the strip “as a protective layer” See col. 2, line 4, or that a protective nonmagnetic coating can be added. If the magnetic strip 13 of Wright is “for protection” then why does it require protection itself? The strip 13 clearly is for supplying a magnetic force.

Moreover, under any definition of coating, the strip 14 of Wright is not a coating. Wright in fact discusses a nonmagnetic coating at col. 2, line 12, and thus distinguishes strips 14 from a coating.

The present invention also makes clear that the milled surfaces with magnet strips such as in Wright are not coatings. See [0005].

Withdrawal of the rejections to claims 1, 8 to 10, 12 and 16 under 35 U.S.C. §102(b) is respectfully requested.

Claim 10: Argued Separately

Claim 10 recites: “A print finishing machine, comprising at least one device for processing a printing substrate as recited in claim 1.”

As known in the art, a print finishing machine is something which finished a product downstream from printing unit. Wright clearly does not disclose any printing finishing machine, explicitly or inherently.

Withdrawal of the rejection to claim 10 for this reason as well is respectfully requested.

Rejections under 35 U.S.C. §103(a): Claims 2, 6, 7, 13 to 15 and 17 Argued Separately

Claims 2, 6, 7, 13 to 15 and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Wright in view of Koga (US 5,424,815).

Koga describes a developing device having a toner carrier with a magnetic field generating layer 63 for the toner.

Claims 2 and 17 recite limitations where the magnetizable coating is an electroplating.

Claim 13 recites the device as recited in claim 1 wherein the thickness of the coating is between .001 and 10 mm.

Claim 14 recites the device as recited in claim 13 wherein the thickness of the coating is .01 mm to 1 mm.

Claim 15 recites the device as recited in claim 1 wherein the rotatable carrier body has an outer surface, the magnetizable coating being distributed in a uniform manner over the outer surface.

It is respectfully submitted that one of skill in the art would not have replaced the strips of Wright with the magnetizable coating of Koga. Wright is completely unsuitable as a toner carrier and requires milling and has outer grooves. Electroplating or providing thin coatings or even coating would make no sense in such a grooved structure. There is also no reason or motivation to change the grooved structure of Wright. In addition, the Koga device is not a tool and is an imaging device for holding toner. The asserted Office Action motivation is also not understood- there is no indication in any prior art for a need or reason to save space in Wright.

Withdrawal of all of the rejections in view of the arguments to claim 1 above is respectfully requested. In addition, withdrawal of the rejections to claims 2, 13, 14, 15 and 17 is also respectfully requested in view of the comments in this section.

Claims 3 and 4: Argued Separately

Claims 3 and 4 were rejected under 35 U.S.C. §103(a) as being unpatentable over Wright in view of Bain (US 5,038,680).

Claim 3 recites the “device for processing a printing substrate as recited in claim 1 wherein the coating is a magnetic, corrosion-resistant stainless steel with a nickel content of 80

% to 95 %” and claim 4 the “device for processing a printing substrate as recited in claim 3 wherein the nickel content is 91 to 93 %, and the rest is iron.”

Bain does not teach the nickel content claimed, and is for a different device.

Claim 5: Argued Separately

Claim 5 was rejected under 35 U.S.C. §103(a) as being unpatentable over Wright in view of Friedrichs (DE 101 47 486 A1).

Claim 5 recites the device for processing a printing substrate as recited in claim 1 wherein the processing tool is a die plate or a perforating plate.

It is respectfully submitted that it would not have been obvious to have used a die plate or perforating plate with the grooved structure of Wright, as the grooved structure would have made die or perforating difficult.

Claim 11: Argued Separately

Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over Wright in view of Albus (US 2001/0045166).


Claim 11 recites a printing press comprising at least one printing unit and a device for processing a printing substrate as recited in claim 1 arranged downstream of the printing unit.

Wright is for use with printing plates (See col. 1, lines 9 to 11), and there is no teaching or motivation in Albus to use such a magnetic holding device “downstream of the printing unit” as claimed.

CONCLUSION

It is respectfully submitted that the application is in condition for allowance. Favorable consideration of this appeal brief is respectfully requested.

Respectfully submitted,
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APPENDIX A:

PENDING CLAIMS 1 TO 17 OF U.S. APPLICATION NO. 10/730,464

- Claim 1 (original): A device for processing a printing substrate comprising:
a rotatable carrier body; and
at least one processing tool accommodated on the rotatable carrier body, the carrier body having, at least partially, a magnetizable coating, the magnetizable coating when magnetized holding the processing tool on the carrier body by magnetic force.
- Claim 2 (original): The device for processing a printing substrate as recited in claim 1 wherein the magnetizable coating is an electroplating.
- Claim 3 (original): The device for processing a printing substrate as recited in claim 1 wherein the coating is a magnetic, corrosion-resistant stainless steel with a nickel content of 80 % to 95 %.
- Claim 4 (original): The device for processing a printing substrate as recited in claim 3 wherein the nickel content is 91 to 93 %, and the rest is iron.
- Claim 5 (original): The device for processing a printing substrate as recited in claim 1 wherein the processing tool is a die plate or a perforating plate.
- Claim 6 (original): The device for processing a printing substrate as recited in claim 1 wherein the carrier body contains steel or a fiber composite.
- Claim 7 (original): The device for processing a printing substrate as recited in claim 6 wherein the carrier body contains cast steel.
- Claim 8 (original): The device for processing a printing substrate as recited in claim 1 wherein the carrier body is magnetizable.

Claim 9 (original): The device for processing a printing substrate as recited in claim 1 wherein the carrier body is a rotating body or cylinder, the processing tool being accommodated on a lateral surface of the rotating body or cylinder.

Claim 10 (original): A print finishing machine, comprising at least one device for processing a printing substrate as recited in claim 1.

Claim 11 (original): A printing press comprising at least one printing unit and a device for processing a printing substrate as recited in claim 1 arranged downstream of the printing unit.

Claim 12 (original): A folder of a web-fed printing press comprising at least one device for processing a printing substrate as recited in claim 1.

Claim 13 (previously presented): The device as recited in claim 1 wherein the thickness of the coating is between .001 and 10 mm.

Claim 14 (previously presented): The device as recited in claim 13 wherein the thickness of the coating is .01 mm to 1 mm.

Claim 15 (previously presented): The device as recited in claim 1 wherein the rotatable carrier body has an outer surface, the magnetizable coating being distributed in a uniform manner over the outer surface.

Claim 16 (previously presented): A method for manufacturing the device as recited in claim 1 comprising the step of coating the rotatable carrier body with the magnetizable coating.

Claim 17 (previously presented): The method as recited in claim 16 wherein the coating step includes electroplating.

APPENDIX B

Evidence Appendix under 37 C.F.R. §41.37 (c) (ix):

No evidence pursuant to 37 C.F.R. §§1.130, 1.131 or 1.132 and relied upon in the appeal has been submitted by appellants or entered by the examiner.

APPENDIX C

Related proceedings appendix under 37 C.F.R. §41.37 (c) (x):

As stated in "2. RELATED APPEALS AND INTERFERENCES" of this appeal brief, appellants, their legal representatives, and assignee are not aware of any appeal or interference that directly affects, will be directly affected by, or will have a bearing on the Board's decision in this appeal.